

### REMARKS / ARGUMENTS

Reconsideration of the application as amended is respectfully requested.

Claims 1-15 were objected to for numerous instances of lack of antecedent basis in the claim language. These claims have been amended in an attempt to overcome such objections.

The examiner respectfully rejected Claims 1, 5, 8-11 and 15 under 35 U.S.C. § 102(b) as being anticipated by Dixon et al.

In undertaking to determine whether one reference anticipates the claim(s) of an application under 35 U.S.C. § 102(a), § 102(b) or § 102(e), a primary tenet is that the reference must teach every element of the claim(s). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The invention described in Dixon et al is, in essence, an vehicle fluid *exchange* apparatus that removes old fluid by creating a fluid loop and pressurizing the vehicle fluid chamber, thereby removing spent fluids AND replacing the fluid chamber with fresh fluid. Such a device lacks a portable storage canister, lacks wheel means to enable ease of positioning and movement this canister, and lack the ability to make such canister of polyethylene or stainless steel. Because not designed to be light weight and portable, such a device lacks handle that enables lifting the device, as well as transporting the device by tilting the device to an angle upon which the transport wheels are engaged to freely rotate. Also, no such

method is described in Dixon et al..

Accordingly, applicant feels that rejection based upon 35 U.S.C. 102 is inappropriate.

Also, the examiner rejected Claim 1 under 35 U.S.C. 102(e) over Zager. Based upon the above arguments, it is felt that the differences between the present invention and this references are such that rejection based upon 35 U.S.C. § 102(e), in is also inappropriate.

Finally, rejections under 35 U.S.C. 103 were cited over

- a. claims 2, 12 and 13 based upon Dixon et al in view of Prestwood et al;
- b. claim 3 based upon Dixon et al in view of Holmes;
- C. Claims 4 and 7 based upon Zager;
- D. Claim 6 based upon Dixon et al in view of Stich et al;
- E. Claim 14 based upon Zager.

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(j). Based upon the numerous differences in feature and function between these references, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element

of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985).

The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (Fed. Cir. 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

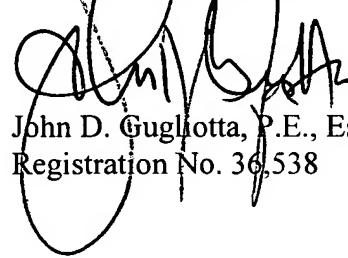
To summarize, it appears that only in hindsight does it appear obvious to one of ordinary

skill in the pertinent art to combine the present claimed and disclosed combination of elements.

To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (Fed. Cir. 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,



John D. Gugliotta, P.E., Esq.  
Registration No. 36,538

The Law Offices of John D. Gugliotta  
202 Delaware Building  
137 South Main Street  
Akron, OH 44308  
(330) 253-5678  
Facsimile (330) 253-6658